

**Amendment and Response**

Applicant: Robert Davidson

Serial No.: 09/760,242

Filed: January 12, 2001

Docket No.: 10002343-1

Title: PERSONAL MOVIE STORAGE MODULE

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**REMARKS**

This Amendment is responsive to the Office Action mailed November 26, 2003. In that Office Action, the Examiner rejected claims 13-15, 17, and 18 under 35 U.S.C. §112, second paragraph as being indefinite; claims 1, 4, 7, 9, 10, and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Cantone, U.S. Patent No. 5,734,781 ("Cantone") in view of Browning, U.S. Patent No. 6,629,193 ("Browning"); claims 2 and 3 were rejected under 35 U.S.C. §103(a) as being unpatentable over Cantone in view of Browning, and further in view of Allen, U.S. Patent No. 5,909,638 ("Allen"); claims 5 and 8 were rejected under 35 U.S.C. §103(a) as being unpatentable over Cantone in view of Browning, and further in view of Chung, U.S. Patent No. 6,628,963 ("Chung"); claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Cantone in view of Browning, and further in view of Marshall, U.S. Patent No. 6,632,175 ("Marshall"); claims 11-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Cantone in view of Browning, and further in view of Gibson et al., U.S. Patent No. 5,557,596 ("Gibson"); claims 16 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Cantone in view of Browning, and further in view of Allen; claim 17 was rejected under 35 U.S.C. §103(a) as being unpatentable over Cantone in view of Browning, and further in view of Allen, and further in view of Chung.

With this Response, claims 2, 3, 5-8, and 13-18 have been amended. Claims 1-18 remain pending in the application and are presented for reconsideration and allowance.

**Specification Objections**

On page 2 of the Office Action, the Examiner objected to two specific informalities within the specification. In particular, the Examiner indicated that the application number corresponding to Attorney Docket No. 10002307-1 is missing and that appropriate correction was required. The Examiner also indicated that in claim 8, wherein the storing and recalling of claim 1 are in a broadband frequency format, is not disclosed in the specification. With this Amendment, pages 1 and 4 of the specification have been amended to appropriately correct these minor informalities. In particular, on page 1 of the application, the application number corresponding to Attorney Docket No. 10002307-1 has been inserted. In addition, on page 4 of the application, language has been added to clarify the recalling and storing of

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selections of an entertainment media in a broadband communication or frequency format. Therefore, proper antecedent basis for the language within claim 8 is provided. Since this language was originally disclosed in the application, specifically in claim 8, no new matter has been added with the present amendment to the specification.

**Claim Rejections under 35 U.S.C. §112**

On pages 3 and 4 of the Office Action, the Examiner rejected claims 13-15, 17, and 18 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. With this Amendment, claims 13, 14, 17, and 18 have been amended. In particular, claims 13 and 14 have been amended by canceling the language "similar to" and replacing the language with appropriate claim language from claim 11. With respect to claims 17 and 18, these claims were inadvertently based upon claim 15. However, upon reviewing the claims, it is clear that claims 17 and 18 should depend from independent claim 16. Therefore, claims 17 and 18 have been amended such that they depend from independent claim 16. With respect to claim 15, the Examiner indicated that claim 15 recites that the limitation "the ultra-high capacity storage device" lacks antecedent basis. However, upon reviewing independent claim 9, from which dependent claim 15 depends, claim 9 includes the language "a portable ultra-high capacity storage device". Therefore, Applicant believes that there is proper antecedent basis for the recited claim language.

In view of the above remarks, Applicant respectfully requests that the rejection of claims 13-15, 17, and 18 under 35 U.S.C. §112, second paragraph, be withdrawn.

In addition, claims 2, 3, 5-8, and 13-16 have been amended to correct some minor informalities.

**Claim Rejections under 35 U.S.C. §103**

On pages 4-8 of the Office Action, the Examiner rejected claims 1, 4, 7, 9, 10, and 15 under 35 U.S.C. §103(a) as being unpatentable over Cantone in view of Browning.

Browning has an issue date of September 30, 2003 and a filing date of October 24, 2000. The present application, however, has a filing date of January 12, 2001. While Browning has a filing date before the filing date of the present application, the publication

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date (issue date) of the Browning patent is after the filing date of the present application. As such the Browning patent is classified as a 35 U.S.C. §102(e) reference.

**The present U.S. Patent Application Serial No. 09/760,242 and the Browning Patent (U.S. Patent No. 6,629,193) were, at the time the invention of the present application was made, owned by Hewlett-Packard Company.**

As Browning only qualifies as prior art under 35 U.S.C. §102(e) and Browning was used in an obviousness rejection under 35 U.S.C. §103(a) and common ownership of the present application and Browning has been established, Applicant submits that under the prior art exclusion of 35 U.S.C. §103(c), Browning does not qualify as a 35 U.S.C. §102(e) reference in an obviousness rejection under 35 U.S.C. §103(a) (*see* MPEP §706.02(l)(3); *see also* MPEP §706.07(a)). Applicant, therefore, respectfully requests that the rejection of claims 1, 4, 7, 9, 10, and 15 under 35 U.S.C. §103(a) be withdrawn and that claims 1, 4, 7, 9, 10; and 15 be allowed.

On pages 8-16, the Examiner rejected claims 2, 3, 5, 6, 8, 11-14, and 16-18 under 35 U.S.C. §103(a) as being unpatentable over Cantone in view of Browning, and in view of at least one of Allen, Chung, Marshall, Gibson et al., or a combination thereof. As previously discussed, Applicant submits that under the prior exclusion of 35 U.S.C. §103(c), Browning does not qualify as a 35 U.S.C. §102(e) reference in the obviousness rejection under 35 U.S.C. §103(a) (*see* MPEP §706.02(l)(3); *see also* MPEP §706.07(a)). Applicant, therefore, respectfully requests that the rejection of claims 2, 3, 5, 6, 8, 11-14, and 16-18 be withdrawn and that all pending claims be allowed.

**CONCLUSION**

Applicant believes independent claims 1, 9, and 16 and the claims depending therefrom, are in condition for allowance. Allowance of these claims is respectfully requested.

Any inquiry regarding this Amendment and Response should be directed to either Philip Lyren at Telephone No. (281) 514-8236, Facsimile No. (281) 514-8332 or Michael R. Binzak at Telephone No. (612) 573-0427, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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**CERTIFICATE UNDER 37 C.F.R. 1.8:**

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 17 day of February, 2004.

By Michael R. Binzak  
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